

REMARKS

Reconsideration of the above-identified case is respectfully requested in view of the following remarks.

Claims 2, 3 and 8-52 are withdrawn from consideration in the Application.

Claims 1 and 4-7 are pending in the Application.

Rejection Under 35 U.S.C. § 112

Claims 1 and 4-7 stand rejected under 35 U.S.C. § 112, second paragraph.

The Office Action states that the term “creating a pre-press proof” is unclear in Claim 1. The Office Action further states that according to the specification, a pre-press proof is created by a lamination transfer process, but the claim states that the laminating process takes place during the embossing step, which takes place after the creating step. Applicant has amended Claim 1 to overcome this 112 rejection.

The Office Action further states that the term “and forming a pre-press proof with a thermal mark” is unclear in Claim 1. The Office Action states that according to the specification and present claim, the embossing step results in formation of a pre-press proof with a thermal mark, but the present claim language implies that another step, different from the embossing step, forms a pre-press proof with a thermal mark. Applicant has amended the claim language to “consisting of” to further clarify that no additional step is needed however, Applicant has also inserted the dpi resolution range of between 1000 and 4000 dpi to be clear that this method produces a very high quality image with an embossed thermal mark on it.

Rejection Under 35 U.S.C. § 103

Claims 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,203,942 (*DeCook, et al.*) in view of U.S. Patent No. 5,359,387 (*Hicks*), U.S. Patent Application Serial No. 2003/0020945 (*Lopez*), U.S. Patent No. 5,451,560 (*Akada, et al.*), U.S. Patent No. 5,429,696 (*Rohleder, et al.*) and U.S. Patent No. 5,327,825 (*Parker, et al.*)

Applicant notes that the Applicant is the owner of the DeCook reference. Accordingly, Applicant hereby submits a Terminal Disclaimer. Applicant believes the terminal disclaimer overcomes the rejections based upon the DeCook reference. The Terminal Disclaimer is included herewith.

Hicks teaches a process wherein negatives are printed in poof form on a single sheet of paper, forming a photographic proof. To simply matters for a customer, the order form is printed on the proof at the same time the negatives are printed. This is simply dual printing, not laminating. Hicks teaches no thermal embossing process for images with a dpi of 1000 – 4000 dpi.

The Lopez reference teaches a method to make a proof sheet with indicia on the sheet. The Lopez reference describes creating a proof sheet by printing the proof sheet. The user marking system of Paragraph [0037] does not discuss embossing the sheet. The identity markers are not embossing markers.

The Akada reference teaches using a thermal head 121 with a printing process for image transfer. The resultant sheet 310 is not a pre-press proof. In this case, the image 204 is laminated on a substrate 201 that is not a pre-press proof.

Applicant's embodiment teaches a pre-press proof as Page 10, Lines 15-28 of the Specification as filed. The pre-press proof are formed by one of three specific methods, not general image printing. The multi-step method for image transfer combines the feature of embossing onto the image transfer sheet in column 33. Applicant respectfully suggests that the image transfer is not a creation of a laminated pre-press proof.

The Parker reference teaches using an embossing belt (see Column 2) to emboss micro-patterns onto "embossable material" that comprises holographic images. Applicant admires the Parker reference, but no pre-press proof is suggested with this embossing technique. The Parker reference also does not suggest the creation of a pre-press proof with a thermal mark on the proof. Additionally, Claims 4-5 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeCook, et al.* in view of *Hicks, Lopez, et al., Akada, et al., Rohleder, et al., Parker, et al.* and U.S. Patent No. 6,177,234 (*Metzger*).

The Metzger reference teaches a process for making high resolution monochromatic or polychromatic proofs, comprising: (a) applying a radiation-sensitive recording layer, optionally containing a colorant or dye, to an

image carrier wherein the image carrier has an image-side surface with a maximum average roughness (R_z) of about 0.25 to about 0.37 μm and wherein the radiation-sensitive recording layer contacts the image-side surface of the image carrier; (b) image wise exposing the radiation-sensitive surface recording layer through a high resolution color separation selected from a frequency modulated screen having a dot diameter of less than 25 μm or a line screen with 2% dots having a resolution above 80 lines/cm; (c) developing the radiation-sensitive surface recording layer of step (b) to form a developed recording layer by selecting from the group consisting of developing the recording layer containing a colorant and applying a toner powder or a toner film when the recording layer does not contain a colorant; (d) optionally applying a second, third or fourth radiation-sensitive recording layer to the preceding developed recording layer and repeating steps (b)-(d); wherein the high resolution monochromatic or polychromatic proofs capture the dot diameter of the frequency modulated screen or the resolution of the line screen to form a high resolution monochromatic or polychromatic proof of said screen or screens.

Applicant is familiar with the Metzger reference. Although, the Metzger reference teaches the formation of monochrome and polychrome proof of high resolution, the Metzger reference does not suggest embossing. The Metzger reference does suggest dual sided proofs, but does not teach embossing.

Creating a thermal mark for pre-press proofs by embossing is advantageous for foil effects used in graphic's packaging as discussed in the Applicant's Specification as filed Page 3, Lines 30-33, and Page 4, Lines 1-2. The pre-press proof with a thermal mark created by embossing is not taught by the combined references.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeCook, et al.* in view of *Hicks, Lopez, et al.*, *Akada, et al.*, *Rohleder, et al.*, *Parker, et al.* and European Patent No. 0949081 (*Hoisington, et al.*)

The Hoisington reference teaches a high resolution ink jet printer comprising a substrate support means for supporting and moving a substrate in a first direction, printhead support means for supporting and moving printhead means in a second direction transverse to the first direction, printhead means supported by the printhead support means including a first printhead for

projecting drops of a first plurality of different inks towards a substrate supported on the substrate support means and a second printhead supported by the printhead support means for projecting a second plurality of different inks towards a substrate supported on the substrate support means, at least two of the different inks projected by each printhead means having the same color and a different density.

The advantages of the Applicant's embodiment are:

1. Applicant's embodiment provides use of a variety of pre-press proofs for packaging;
2. Applicant's embodiment requires fewer steps in the process of creating the thermal mark; thereby leading to a less expensive film packaging; and
3. Applicant's fewer steps in the embodiment also leads to higher quality film packaging with great color images.

The Hoisington reference teaches a simple ink-jet printer without the use or mention of an embossing belt to create thermal marks in pre-press proofs.

Applicant's embodiment of a rapid embossing process to create thermal marks in still warm pre-press proofs is believed unobvious in view of the cited references.

Reconsideration of the claims, Specification, and figures as amended is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 29,134

Nelson A. Blish/tmp
Rochester, NY 14650
Telephone: 585-588-2720
Facsimile: 585-477-4646

Enclosures: Terminal Disclaimer
 Replacement Figures 1, 2, and 7
 Annotated Sheets Showing Changes
 Copy of Letter to the Official Draftsperson
 Copy of Formal Drawings

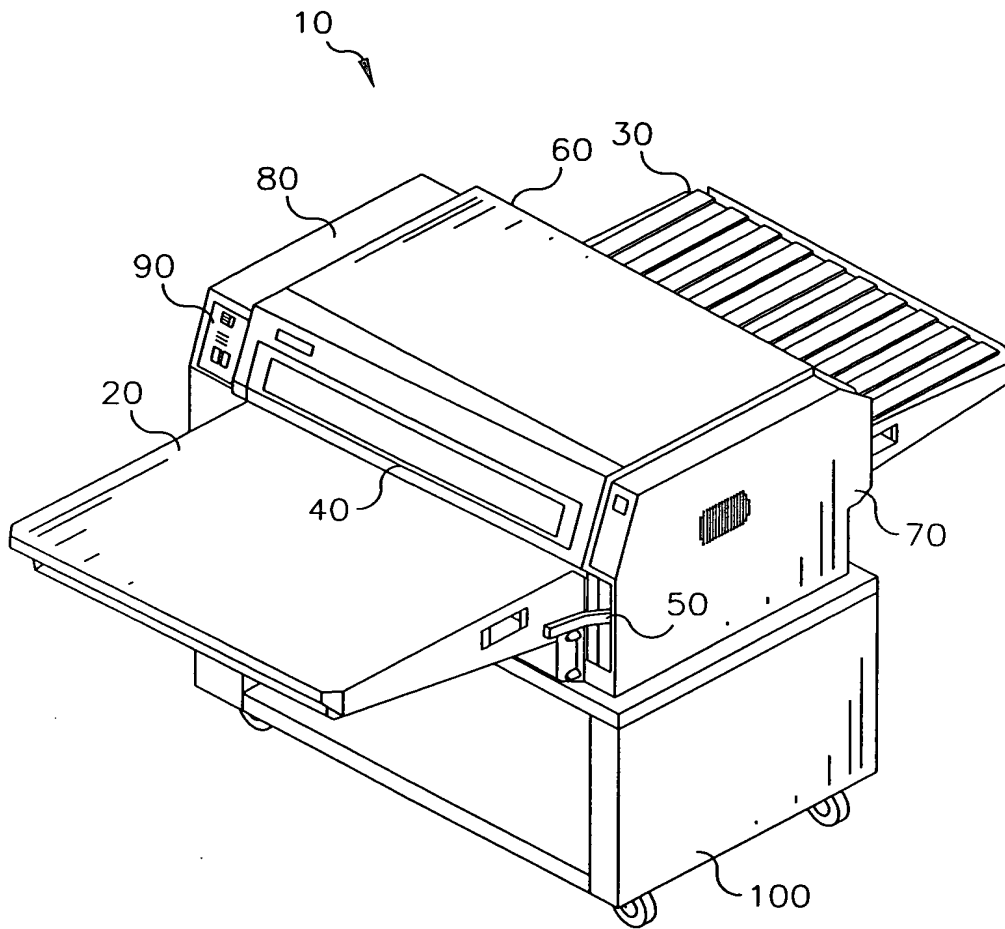


FIG. 1
(PRIOR ART)

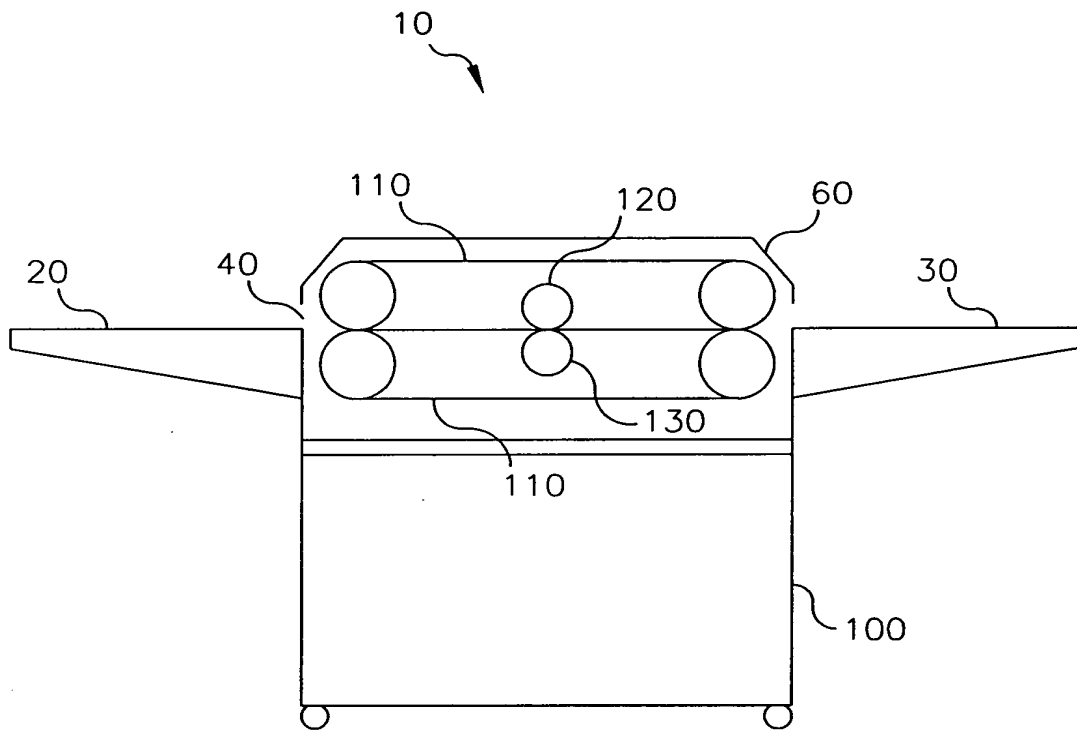


FIG. 2
(PRIOR ART)

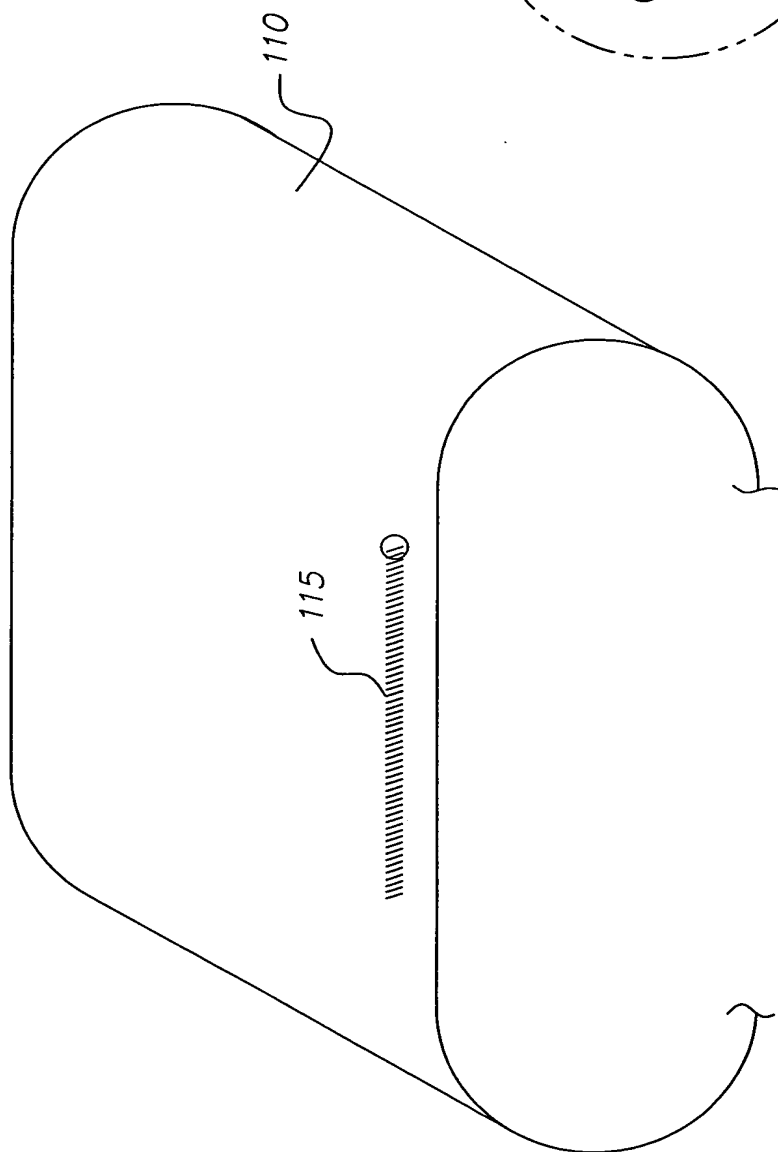
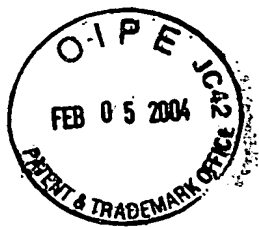


FIG. 7

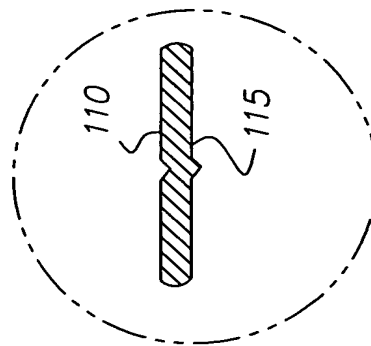


FIG. 8

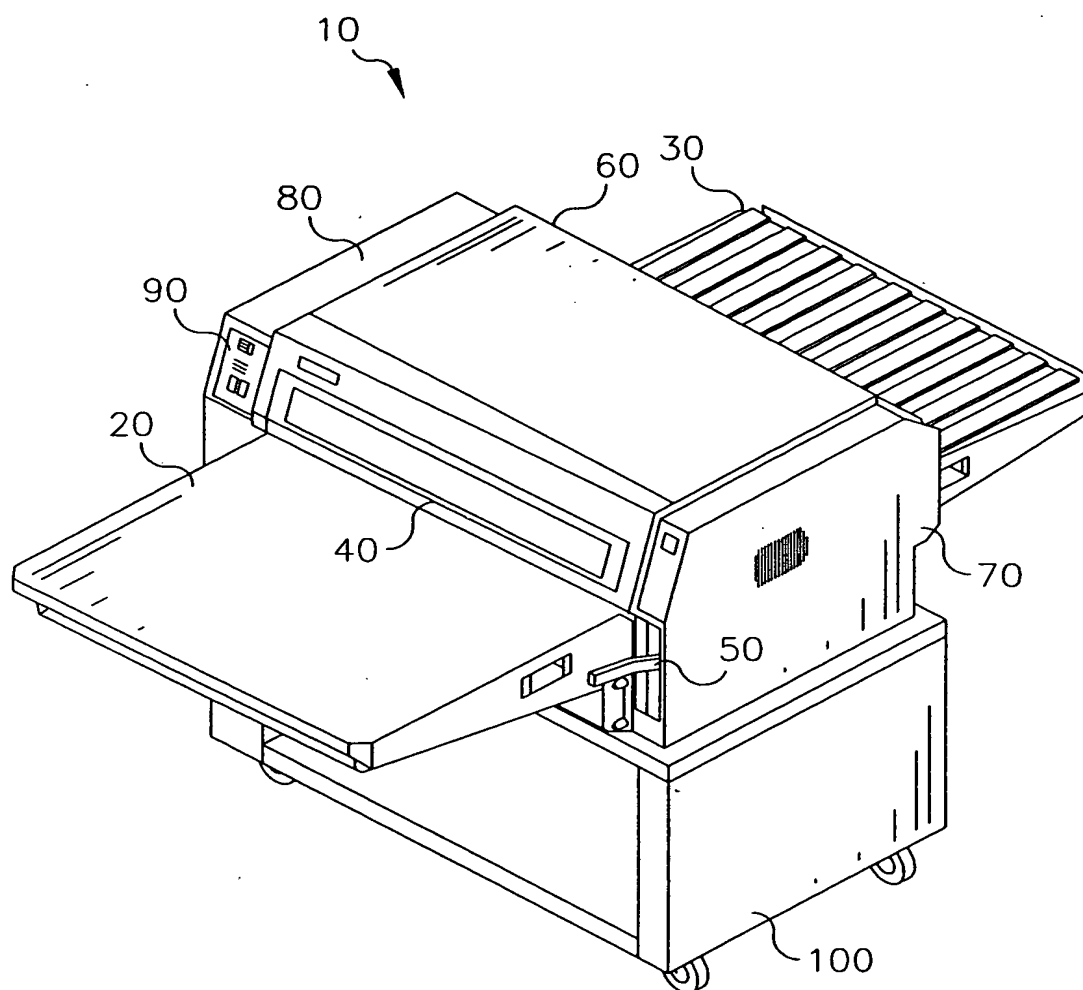


FIG. 1
PRIOR ART



Application No. 10/020,772
Amdt. Dated Feb. 3, 2004
Reply to Office Action of Nov. 4, 2003
Annotated Sheet Showing Changes

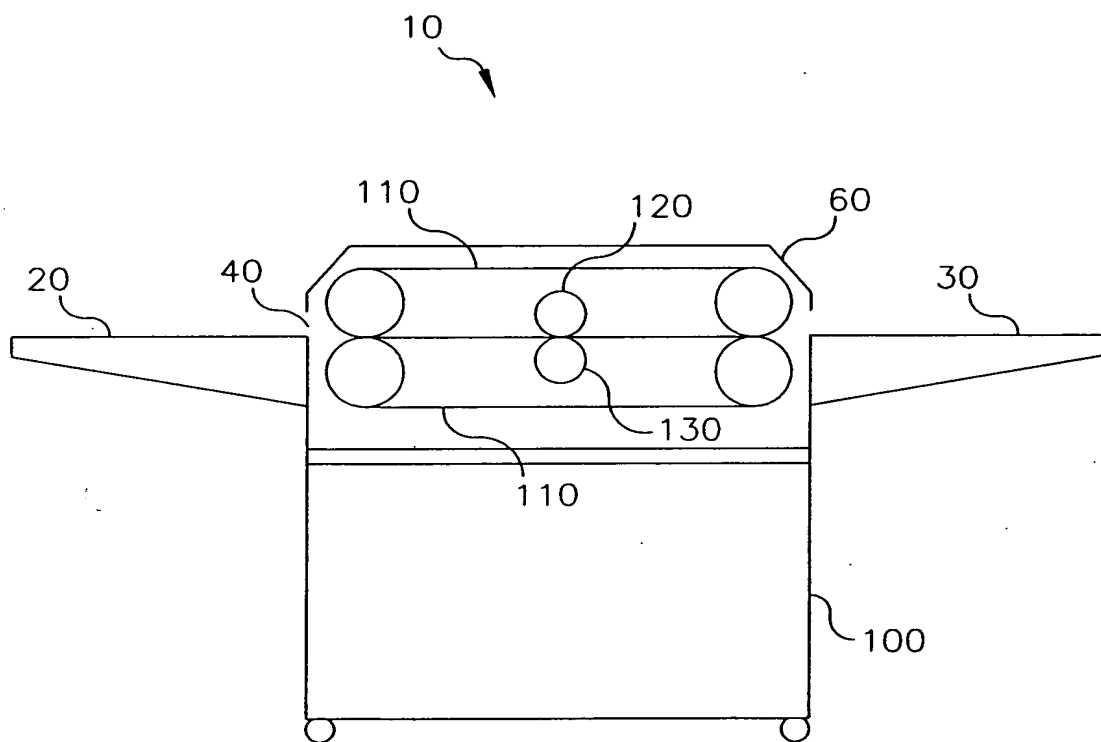


FIG. 2
PRIOR ART



Application No. 10/020,772
Amdt. Dated Feb. 3, 2004
Reply to Office Action of Nov. 4, 2003
Annotated Sheet Showing Changes

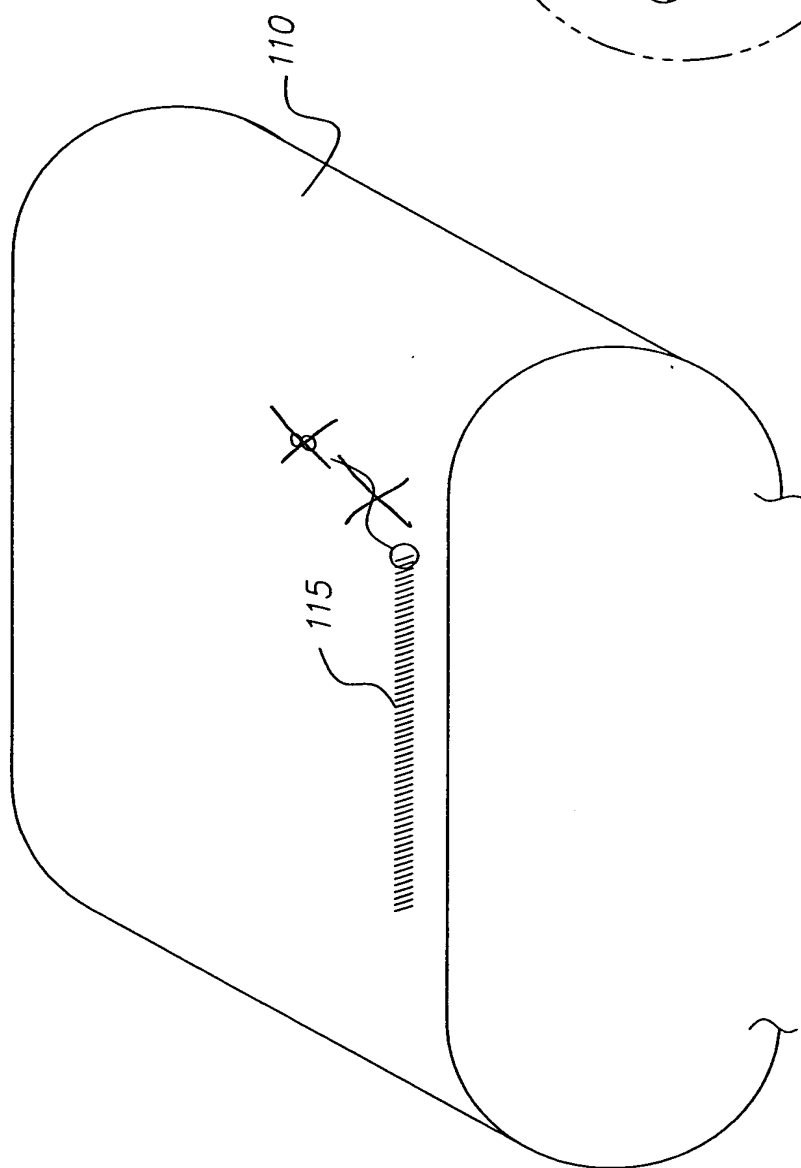


FIG. 7

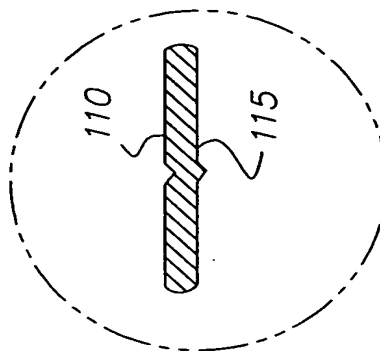


FIG. 8